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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,642	04/02/2004	Kia Silverbrook	HYC007US	9566
24011 7590 08/28/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
UBER, NATHAN C				
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3622				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,642

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

NATHAN C. UBER

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7, 10, 12, 13, 18, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 10, 12, 13, 18, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the amendment filed on 21 May 2008.
2. Claims 1-3, 5, 7, 10, 12, 13, 18 and 29 have been amended.
3. Claims 4, 6, 8, 9, 11, 14-17, 19-27, 30-38 have been canceled.
4. Claims 1-3, 5, 7, 10, 12, 13, 18, 28 and 29 are currently pending and have been examined.

### **Drawings**

5. The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they were replete with reference characters not mentioned in the description. Applicant satisfactorily addressed this objection. The objection is hereby rescinded.

### **Double Patenting**

6. Claims 1-12, 14, 17-20, 22-25, and 28-38 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-50 of prior U.S. Patent No. 7,137,549. Claims 4, 6, 8, 9, 11, 14, 17, 29, 20, 22-25 and 30-38 were canceled by Applicant's amendment on 21 May 2008. Further Applicant amended claims 1-3, 5, 7, 10, 12, 18, 28 and 29 in an attempt to overcome this rejection. However Applicant's amendments included simply moving limitations from one claim to another. The currently amended claims are still found substantially claimed in U.S. Patent No. 7,137,549. The conflicting claims were neither canceled nor substantially amended to overcome this rejection. This rejection is therefore maintained with respect to claims 1-3, 5, 7, 10, 12, 18, 28 and 29.
7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg.*

*Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

8. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

#### **Claim Objections**

9. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. This claim is interpreted as a dependent claim because it references a previous claim. However, this claim is an improper dependent because it is a different statutory class of invention from the referenced claim and because it fails the infringement test. A reasonable interpretation of this claim is a paper document containing code. Such a *label* may be infringed without ever infringing the methods of claim 1 or 18 because infringing a method claim requires practicing the method; simply creating a *label* with code does not require actually practicing or implementing the methods.

#### **Claim Rejections - 35 USC § 112**

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
11. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 depends from claim 11 which was canceled by Applicant's amendment on 21 May 2008. Claim 12 therefore lacks proper antecedent basis.

**Claim Rejections - 35 USC § 102**

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
14. Claims 18 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (4,554,446).

**Claim 18:**

Murphy discloses an inventory control system that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66). Murphy discloses a sensing device at column 4, line 43-44, and accumulating coupon redemption information on page 4, line 55.

**Claim 28:**

Murphy discloses coupons and labels with human and machine readable indicia (see at least column 4, lines 27-32, see also Figure 3).

**Claim Rejections - 35 USC § 103**

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 1-3, 5, 7, 13 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (4,554,446) in view of Lazzouni et al. (U.S. 5,661,506).

**Claims 1-3, 5, 7, 13 and 29:**

Murphy discloses an inventory control method that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66). Murphy particularly notes several different types of coupons including coupons disposed on the product itself as well as coupons that require the customer to transmit customer identification data to the product manufacturer. Murphy points out that in situations where coupons require interaction from the customer, many customers cannot be bothered (a sentiment echoed in applicant's specification), so Murphy solved this problem by creating coded forms and ID cards so

that the customer can simply transmit requisite personal information electronically by swiping or entering their coded information. The coupon redemption methods are discussed broadly in columns 9 and 10. Lines 9/18-29, 9/48-61 and 10/22-46 are particularly relevant to applicant's claims directed towards transmission of coupon and customer information as well as submitting electronic forms.

With respect to the new limitations in claim 1 directed to sensing machine readable code, position data and redemption information, Murphy discloses at least two sensing steps (swipe and scan) as well as receiving and transmitting redemption information as previously discussed. Further the barcode scanning of Murphy inherently requires the generation of position data as this is the basis for successful bar code scanning. The sensing device must identify the position of the registration posts on the bar code before it can interpret the code residing between the posts. Additionally the position of the bar code itself is inherently valuable to the sensing and data gathering step, especially for products or barcode sheets that may have multiple bar codes. However, Murphy does not disclose the narrower interpretation of *interaction data* as may be gleaned from the specification. Lazzouni, in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on substrate that is coded with infrared machine readable coordinate code. It would have been obvious to one having ordinary skill in the art at the time of the invention to enhance the Murphy invention by integrating additional coded data into printed labels and coupons since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

#### **Claims 10 and 12:**

Murphy does not disclose the limitations of claims 10 and 12. However, Lazzouni in at least in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1

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discloses generating interaction data based on sensing the position of a scanning device on coded substrate. The *interaction data* includes a digital representation of writing (see at least Figure 1) and movement data (see at least column 4, lines 46-50).

#### **Response to Arguments**

18. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.



**Conclusion**

19. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
21. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

22. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
27 August 2008

/Arthur Duran/

Primary Examiner, Art Unit 3622